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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,565	07/10/2003	Barry D. Hand	8266-1087	2790

7590 01/13/2004

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EXAMINER

LEE, JONG SUK

ART UNIT PAPER NUMBER

3673

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/616,565	Applicant(s) HAND ET AL.	
	Examiner Jong-Suk (James) Lee	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 14-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9-13, 17 and 18 is/are objected to.
- 8) ☒ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> | 6) <input type="checkbox"/> Other: ____ |

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2

DETAILED ACTION

3

4

Specification

5

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should be amended to be commensurate with the claimed invention, i.e., **Hospital Proning Bed**.

8

9

Claim Objections

10

2. Claim 17 is objected to because of the following informalities:

11

Claim 17, line 1: "anterior body portion" should be --the anterior body portion--.

12

Appropriate correction is required.

13

14

Claim Rejections - 35 USC § 102

15

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

16

17

A person shall be entitled to a patent unless --

18

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19

20

21

4. Claims 1-3, 8, 14, 15, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being

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1 anticipated by PCT Application Publication (WO 99/07320).

2 PCT Application Publication (WO 99/07320) discloses a proning bed comprising of: a
3 fluid supply; a bed support (10) coupled to the fluid supply, a body portion (22, 24, 46) and a
4 support plate (42, 44) removably coupled to the body portion as depicted in Fig. 5, the body
5 portion including a guide (60) configured to operably couple with the support plate in order to
6 guide the support plate in sliding movement into the posterior body portion, a patient support
7 surfaces/mattresses (170) configured to operably couple to and be separated from the bed support
8 (10), the patient support surface/mattresses being in communication with the fluid supply
9 automatically when the patient support is coupled to the bed support; the bed support further
10 including a base (12), the support plate and the patient support surface about a longitudinal axis
11 of the patient support surface, the patient support surface/mattresses being coupled to the support
12 plate (42, 44); a mover (55) and an anterior bed support (112) coupled to the bed support (42,
13 44), the anterior bed support including a mattress (196) and the mover being configured to move
14 the patient support surface and mattress of the anterior bed support (see Figs. 1-19; from page 8,
15 line 10 to page 13, line 23).

16
17 5. Claims 1-3, 8, 14, 15, 16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being
18 anticipated by Stryker (US 3,302,218).

19 Stryker discloses a turning bed comprising of: a posterior bed support (12) including a

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1 base (11), a posterior body portion (71) coupled to the base, and a support plate (116) configured
2 to be removably coupled to the posterior body portion (71, 84), the body portion including a
3 guide (73, 75) configured to operably couple with the support plate in order to guide the support
4 plate in sliding movement into the posterior body portion, a patient support surface (108)
5 configured to be releasably coupled to the support plate, an anterior bed support (18) being
6 coupled to the posterior bed support and an anterior body portion (83), an anterior support plate
7 (137) configured to be removably coupled to the anterior and supported for sliding movement
8 into the anterior body portion, and a proning support surface (131) coupled to the anterior
9 support plate (137), a mover (95) to rotate the patient support surface about a longitudinal axis
10 (see Figs. 1-8; col.4, lines 64-75; col.5, lines 1-75; col.6, lines 1-47; col.7, lines 11-75; col.8, lines
11 1-45).

12
13 ***Obviousness-Type Double Patenting***

14 6. The nonstatutory double patenting rejection is based on a judicially created doctrine
15 grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
16 improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
17 harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
18 Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
19 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
20 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

21 A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to

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1 overcome an actual or provisional rejection based on a nonstatutory double patenting ground
2 provided the conflicting application or patent is shown to be commonly owned with this
3 application. See 37 CFR 1.130(b).

4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
5 disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
6

7 7. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double
8 patenting as being unpatentable over claims 1-3, 5-8, 10, 15, 16 and 26-31 of U.S. Patent No.
9 6,609,260.

10 Although the conflicting claims are not identical, they are not patentably distinct from each
11 other because the present claimed invention is somewhat broader recitation of the '260 patent, for
12 example, in claims 1, 4 and 5 of present claimed invention and claims 1, 5, 6 and 10 of '260
13 Patent, the Applicants claim:

14 I) "a posterior bed support including a base, a posterior body portion coupled to the base,
15 and a posterior support plate configured to be removably coupled to the body portion and
16 supported for sliding movement into the posterior body portion, and an anterior bed support
17 coupled to the posterior bed support, the anterior bed support including an anterior body portion
18 and supported plate configured to be removably coupled to the anterior body portion and
19 supported for sliding movement into the anterior body portion and a proning support surface
20 coupled to the anterior support plate" (as recited in claim 1);

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1 ii) “the posterior body portion including a plurality of fluid passageways, the posterior
2 body and the posterior support plate includes a plurality of fluid passageways configured to
3 communicate with the fluid passageways of the posterior body portion when the posterior support
4 plate is coupled to the posterior body portion” (as recited in claim 4)

5 iii) “a fluid supply coupled to the plurality of fluid passageways of the posterior body
6 portion” (as recited in claim 5);

7 whereas in '260 Patent, the Applicants claim “a fluid supply, a (posterior) bed support
8 coupled to the fluid supply, and a patient (proning) support surface configured to couple to.....the
9 bed support...” (in claim 1); “...an anterior bed support coupled to the bed support.....” (in claim
10 5); “the anterior bed support includes a passageway of the anterior bed support being in
11 communication with the fluid supply....” (in claim 6); and “the bed support includes a passageway
12 having an inlet and an outlet, the fluid supply is coupled to the inlet of the passageway,” (in
13 claim 10);..etc.

14
15 Therefore, in respect to above discussions, it would have been obvious to one of ordinary
16 skill in the art at the time the invention was made to use the teachings of claims 1, 5, 6 and 10 of
17 '260 patent as a general teachings for the proning hospital bed as claimed by the present
18 application. The instant claims obviously encompass the claimed invention of '260 Patent and
19 differ only in terminology. To the extent that the instant claims are broaden and therefore generic

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1 to the claimed invention of '260 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993,
2 states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has
3 been previously been claimed in a co-pending application.

4 A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and © may be used
5 to overcome an actual or provisional rejection based on a nonstatutory double patenting ground
6 provided the conflicting application or patent is shown to be commonly owned with this
7 application. See 37 CFR 1.130(b).

8 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
9 disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10
11 ***Allowable Subject Matter***

12 8. Claims 6, 7, 9-13, 17 and 18 are objected to as being dependent upon a rejected base
13 claim, but would be allowable if rewritten in independent form including all of the limitations of
14 the base claim and any intervening claims.

15
16 ***Conclusion***

17 9. The prior art made of record and not relied upon is considered pertinent to applicant's
18 disclosure. Other references cited disclose a prone bed, a hospital bed and an operation table.

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10. Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The
examiner can normally be reached between the hours of 6:30 AM to 3:00 PM Monday thru
Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for this
Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 308-2168.

J. Lee /jjl
January 8, 2003



**Jong-Suk (James) Lee
Primary Examiner
Art Unit 3673**